

REMARKS

In an Office Action dated April 10, 2001, the prior Examiner, Examiner Parisi, rejected claims 1, 3, 5, and 6 under 35 U.S.C §102(a) as being anticipated by Ticketmaster.com as described in an article entitled "Site to Let Buyers Print Tickets at Home", ("the article"). In responding to this rejection the Applicant submitted a Declaration Of Prior Invention In The United States To Overcome Cited Prior Publication (37 C.F.R. 1.131) ("the Declaration"). The previous Examiner issued another Office Action dated July 13, 2001, in which the Examiner considered the Declaration, but deemed it unpersuasive and insufficient to overcome the prior rejections because the previous Examiner believed that the Declaration did not show a reduction to practice prior to the effective date of the reference. In response to this Office Action, Applicant filed a Response To Office Action After Final ("Response") on October 31, 2001, arguing that the Declaration was submitted to show conception of the invention prior to the effective date of the reference. However, such Response was not received by the U.S. Patent and Trademark Office until January 8, 2002, due to the mail delays in Washington, D.C. (as evidenced by the U.S. Patent and Trademark Office's date stamp on a reply postcard send back to Applicant's attorney).

A new Examiner was then assigned to this application.

The new Examiner, Examiner Kalinowski, mailed an Advisory Action on February 8, 2002. **In the Advisory Action, Examiner Kalinowski accepted Applicant's arguments submitted in the Response establishing conception of the invention prior to the effective date of the article.** However, Examiner Kalinowski indicated that the Declaration was insufficient to establish diligence during the critical

period that began just prior to the effective date of the article up to the date of a reduction to practice.

Applicant has enclosed with this Preliminary Amendment a Supplemental Declaration in which Applicant presents evidence to establish diligence between the period of January 20, 2000, to March 17, 2000, the date of a constructive reduction to practice which was the filing date of this application. In particular, diligence is shown in the Supplemental Declaration from the time period between January 20, 2000, to March 17, 2000, by the following facts and documents.

After the conception date and prior to the effective date of the reference, Applicant had a meeting with his patent attorney on January 20, 2000. After that meeting and on January 20, 2000, Applicant requested that a patentability search be conducted and such was conducted. It was Applicant's understanding that the patentability search would entail his patent attorney requesting an associate in Washington, D.C. to conduct a hand search of the patents in the U.S. Patent and Trademark Office and that such search could take a minimum of three to four weeks to complete. Enclosed in the Supplemental Declaration and identified as Exhibit C is a copy of a letter Applicant's patent attorney sent on January 21, 2000, to an associate in Washington, D.C. to conduct a patentability search.

Also enclosed in the Supplemental Declaration and identified as Exhibit D is a copy of the letter Applicant's patent attorney received back from the associate in Washington, D.C., which included the results of the search. Although this letter indicates a mailing date of January 31, 2000, the backside of the letter indicates that such letter was not received by Applicant's patent attorney until February 7, 2000. Applicant's patent

attorney reviewed the patentability search and prepared a patentability search report during February 8, 2000, and February 9, 2000. Applicant's patent attorney sent the patentability search report to Applicant on February 9, 2000.

Applicant received a copy the patentability search report on February 10, 2000. Enclosed in the Supplemental Declaration in redacted form and identified as Exhibit E is a copy of the search report dated February 9, 2000, from Applicant's patent attorney. The search report was five pages long and contained seven U.S. patents. These seven patents are attached to the Supplemental Declaration and are identified as Exhibits F, G, H, I, J, K and L. These patents were submitted to the U.S. Patent and Trademark Office in an Information Disclosure Statement as part of Applicant's duty of disclosure.

Since this was Applicant's first experience with patents, Applicant carefully reviewed the search report and the patents from February 10, 2000, until February 18, 2000.

On February 18, 2000, Applicant completed his review of the search report and the patents and Applicant phoned his patent attorney to discuss these patent references and also to set up an appointment to discuss the preparation of a patent application and the patent application process. The first appointment date which Applicant's patent attorney had available was February 21, 2000.

Applicant met with his patent attorney on February 21, 2000, and at such meeting Applicant informed his patent attorney to prepare a patent application. It was Applicant's understanding from his patent attorney that due to his patent attorney's schedule it would take between three and four weeks for the preparation of a patent application.

On March 15, 2000, Applicant's patent attorney mailed out to Applicant a draft of the patent application and Applicant received a copy of a draft of the patent application on March 16, 2000. Enclosed in the Supplemental Declaration and identified as Exhibit M is a copy of a letter dated March 15, 2000, from Applicant's patent attorney which included a copy of the draft of the patent application. On March 16, 2000, Applicant reviewed the draft of the patent application and after Applicant's review was complete Applicant phoned his patent attorney to set up an appointment for Applicant to finalize the patent application with his patent attorney and to file the patent application. The next available appointment date that Applicant's patent attorney had was March 17, 2000.

On March 17, 2000, Applicant met with his patent attorney and they finalized the patent application. At this meeting Applicant also executed formal papers that were required to be submitted with the patent application. Enclosed in the Supplemental Declaration and identified as Exhibits N and O are copies of the Declaration and a Verified Statement Claiming Small Entity Status which were submitted with this patent application with date of execution of this documents being March 17, 2000. The patent application was filed on March 17, 2000.

As the above shows and the Supplemental Declaration shows, Applicant was diligent from prior to the effective date of the reference to a subsequent filing of the patent application. The entire period between January 20, 2000, and March 17, 2000, has been accounted for by affirmative acts. *In re Nelson*, 164 USPQ 458 (CCPA 1970) stated at page 459 that "constant effort is not required". However, in this particular case, constant effort has been shown. "It is well settled that, to satisfy the "reasonable diligence" requirement of 35 USC §102(g), the work relied on must ordinarily be directly

related to reduction to practice of the invention..." *Naber and Lockwood v. Cricchi*, 196 USPQ 294, 296 (CCPA 1977), *cert. denied*, 439 U.S. 826 (1978); See also *Anderson v. Scinta*, 152 USPQ 584 (CCPA 1967); *Martin v. Snyder*, 102 USPQ 306 (CCPA 1954); *Gunn v. Bosch*, 181 USPQ 758 (Bd. Pat. Inter. 1973); *Moore v. Harris v. Hale*, 92 USPQ 187 (Bd. Pat. Inter. 1951). All of the work relied on, the conducting of a patentability search, the review of the search, and the preparation of the patent application, was directly related to the constructive reduction to practice of the invention. Additionally, the diligence of the patent attorney in preparing and filing the patent application inures to the benefit of the inventor. It is submitted that there was diligence on the part of the patent attorney in preparing and filing the patent application. See *Emery v. Ronden*, 188 USPQ 264, 269 (Bd. Pat. Inter. 1974).

It has been suggested in the MPEP at 2138.06 that even a two day period lacking activity has been held to be fatal for showing diligence. The MPEP cites the case of *In re Mulder*, 219 USPQ 189 (Fed. Cir. 1983) for this proposition. However, it is submitted that this case is misstated in the MPEP. In particular, when the case is read, it does not hold that a two day gap of inactivity is fatal for showing diligence. To the contrary, in this particular case, all the applicant had to do was show diligence during only a two day period. However, the applicant was not capable of showing diligence for almost three months, with such two day period falling within this three month period. It is submitted that there has been no period of inactivity in this case and diligence during the critical period has been shown.

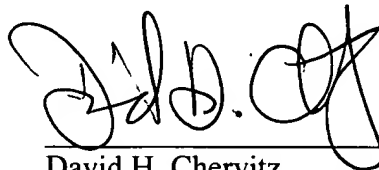
Applicant submits that when the Supplemental Declaration is considered that the Supplemental Declaration shows conception of the invention prior to the effective date of

the reference coupled with due diligence from prior to said date to a subsequent filing of the application. It is believed that the article is not a proper prior art reference and the rejection of claims 1, 3, 5, and 6 under §102(a) should be withdrawn. The remainder of the claims has been rejected under 35 U.S.C. §103(a) in view of the article in combination with various other references. In view of the Supplemental Declaration, it is submitted that the article is not a proper prior art reference and that the rejection of the claims under §103(a) should now be withdrawn.

Applicant has amended this application by adding new claims 21-25 by this Preliminary Amendment. It is submitted that claims 21-25 are allowable over the prior art.

Applicant submits that upon entry of the new claims and consideration of the above remarks this application should be in condition for allowance. In the event that this application is for any reason not considered by the Examiner to be in form for allowance, Applicant's counsel requests the Examiner to telephone the undersigned before issuing a further action to discuss any objections the Examiner might have, thereby simplifying and expediting the examination and prosecution process.

Respectfully submitted,



David H. Chervitz  
Registration No. 32,820  
POLSTER, LIEDER, WOODRUFF  
& LUCCHESI, L.C.  
763 South New Ballas Road, Suite 230  
St. Louis, Missouri 63141  
(314) 872-8118

**RECEIVED**

**MAR 13 2002**

**OFFICE OF PETITIONS**